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today was not written for publication and
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Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAROLD D. PORTNOY and MICHAEL G. STYS

Appeal No. 2004-1461
Application No. 09/461,883

ON BRIEF

Before JERRY SMITH, DIXON and BARRY, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from
the examiner's rejection of claims 1-4, 6-11, 13-20, 22-30, 32-35
and 37-39 which constitute all the claims in the application.

The disclosed invention pertains to an apparatus for use
by a patient to provide informed consent to a medical procedure
using the Internet.

Representative claim 1 is reproduced as follows:

1. An Internet-enabled system for use by a patient to provide informed consent to a medical procedure, comprising:

a patient interface connected to the Internet, the patient interface having at least one input device for use by the patient to provide input to the interface and a screen for displaying information to the patient; and

a web server connected to the Internet in operative communication with and remotely located from the patient interface, the server comprising a program stored in memory and accessible by the patient interface, and memory comprising a user database for permitting registered users to access the system, and a medical procedure database for storing information regarding a plurality of medical procedures;

the interface being operable under control of the program, in response to an authorized access to the system by a registered user in said user database, to present information concerning a medical procedure selected from said plurality of medical procedures to the patient via the screen to request input from the patient via the input device regarding the selected medical procedure, and to determine from the input whether the patient has reviewed all of the information presented regarding the selected medical procedure; and the interface further being operable under control of the program to generate a consent form for the selected medical procedure for review by a physician and execution by the patient when said patient input indicates the patient has reviewed said information.

The examiner relies on the following references:

Rakshit et al. (Rakshit)	5,799,282	Aug. 25, 1998
Iliff	6,234,964	May 22, 2001
		(filed Mar. 13, 1998)

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Claims 1-4, 6-11, 13-20, 22-30, 32-35 and 37-39 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Iliff in view of Rakshit with respect to claims 1-4, 6-11, 14-20, 22-30, 32-35, 38 and 39, with "Official Notice" added with respect to claims 13 and 37.

Rather than repeat the arguments of appellants and the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

Appellants have nominally indicated that the claims are separately patentable, but they have not specifically argued the limitations of each of the claims. The extent of appellants' arguments, with respect to the dependent claims, appears on pages 12-17 of the brief wherein it is stated what is recited in each of the claims. Then it is baldly asserted that the prior art does not teach or suggest the features of these claims, but offers no analysis or discussion of obviousness whatsoever. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). At the time appellants' brief was filed, 37 CFR § 1.192(c)(7) required that the argument explain "why the claims . . . are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." Appellants' arguments fail to satisfy this requirement as a basis to have the claims considered separately for patentability. Since appellants are considered to have made no separate arguments for patentability

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with respect to the dependent claims, the dependent claims will stand or fall with the claims from which they respectively depend. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

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776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to independent claims 1, 16 and 26, the examiner finds that Iliff teaches the claimed invention except that Iliff does not disclose software which determines whether or

not the patient has reviewed all of the data and which subsequently prints out a consent form. The examiner cites Rakshit as teaching a system for determining informed consent from a patient. The examiner finds that it would have been obvious to the artisan to modify the disease management system of Iliff to include instructions for determining informed consent as taught by Rakshit [answer, pages 3-4].

Appellants argue that although Iliff teaches determining consent, it is not informed consent. Appellants also argue that Iliff is concerned with disease therapy and not with medical procedures as claimed. Appellants argue that Rakshit does not suggest use of a web server, a network interface, and multiple databases as part of an informed consent procedure. Finally, appellants argue that there is no suggestion or motivation to combine the references [brief, pages 9-12].

The examiner responds that the discussion of [informed] consent in Iliff provides a nexus to the informed consent teachings of Rakshit. The examiner also maintains his belief that the consent in Iliff is informed consent and that Rakshit teaches the use of a series of questions to test the patient's

understanding of the consent. The examiner notes that appellants have argued alleged individual deficiencies in the references with respect to teachings for which they are not relied on. Finally, the examiner responds that the artisan would have been motivated to modify Iliff to include the informed consent teachings of Rakshit [answer, pages 7-9].

Appellants respond by reiterating their belief that the consent in Iliff is not informed consent. Appellants also respond that Iliff is unrelated to the present invention and no modification of Iliff is proper [reply brief].

We will sustain the examiner's rejection of independent claims 1, 16 and 26. Appellants' argument that Iliff does not relate to a medical procedure is not persuasive for at least two reasons. First, the artisan would have understood that providing information with respect to the treatment for a disease clearly suggests the recitation of providing information concerning a medical procedure. Second, Rakshit clearly relates to providing information with respect to a medical procedure so that the collective teachings clearly relate to a medical procedure. Appellants' argument that the consent in Iliff is not informed

consent is also not persuasive. In our view it does not matter whether the consent in Iliff constitutes informed consent. The very fact that the consent in Iliff is not informed consent, as argued by appellants, provides the very motivation for modifying Iliff in the manner proposed by the examiner. In other words, it was understood in this art that any consent obtained from a patient should be informed consent. To the extent that the consent in Iliff may be considered uninformed consent, the artisan would have been motivated to improve the consent procedure so that there would be no question that the consent was informed consent. Thus, the artisan would have been motivated to look to prior art which provides acceptable informed consent. Rakshit clearly provides the type of informed consent which would improve upon the type of consent obtained in Iliff. We agree with the examiner that the artisan would have been motivated to modify the system of Iliff so that the consent is obtained in the manner taught by Rakshit to ensure that the consent is informed consent. Both references relate to the treatment of medical conditions so that the artisan should have been familiar with each of the references.

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As noted above, the dependent claims fall with the independent claims because they have not been separately argued for patentability. With respect to claims 13 and 37, which are rejected using the additional teachings of "Official Notice," we also sustain the rejection of these claims. The examiner's explanation of this rejection is sufficient to have established a prima facie case of obviousness. Since appellants have not offered any arguments in rebuttal with respect to this rejection, the prima facie case of obviousness has not been overcome.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4, 6-11, 13-20, 22-30, 32-35 and 37-39 is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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LANCE LEONARD BARRY)	
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JS/vsh

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